

## REMARKS

This Amendment is responsive to the Office Action of October 16, 2006. Entry of this amendment and reconsideration of the subject application in view thereof are respectfully requested.

### Status of Claims

Claims 1-20 were pending in this application. Of these, claims 4-8, 11, 12 and 18-20 have been withdrawn without prejudice from further examination as being drawn to a nonelected invention, and claims 1-3, 9, 10 and 13-17 have been rejected. Claims 10, 14, 15 and 17 have been amended to clarify the invention. Claims 9, 13, and 16 have been canceled. No new claims have been added. No new matter has been added.

### Information Disclosure Statement

The Examiner noted on page 2 of the Office Action that "in the IDS filed August 25, 2004, it is noted that only the abstracts of the patent were filed." Applicants respectfully submit that they will attend to filing the IDS with copies of the references in due course with the U.S. Patent and Trademark Office.

### Rejection Under 35 U.S.C. § 102

Prior claims 9, 13, 14 and 16 stood rejected under 35 U.S.C. § 102(e) as being anticipated by Colpan et al., U.S. Patent 6,383,393 ("Colpan"). Applicants respectfully traverse this rejection.

Colpan teaches a method for the purification and separation of nucleic acids. Colpan teaches the use of a protease, a chaotropic salt, and a surfactant (or a detergent) in its method. However, Colpan does not teach a step of "adding at least one of compounds which are any of aliphatic ether, aliphatic ester, and aliphatic ketone, containing 2 to 10 carbon atoms . . ."

The Examiner contends that "Triton is a compound which comprises 2 to 10 carbon atoms and is [an] aliphatic ether." Applicant respectfully disagrees. Triton X-100 is t-octylphenoxyethoxyethanol (commonly described as alkylaryl polyether alcohol). Clearly, Triton X-100 has an aromatic group and an ether side chain (see the copy submitted herewith of page 973, Sigma catalog, 2000-2001). Thus, Triton X-100 is not an aliphatic ether because it has an aromatic group (Ar) forming an ester link with an aliphatic group.

Therefore, Colpan fails to teach the use of aliphatic ethers, and the Examiner's contention that "Triton is an aliphatic ether" is in error.

Since anticipation requires that each and every limitation of a claim be found either expressly or inherently in a single prior art reference (*Bristol-Myers Squibb v. Ben Venue*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)), Colpan fails to anticipate the claimed invention.

As such, given the strict identity required of the test for novelty, the Examiner has not established a *prima facie* case of anticipation in support of the rejection of prior claims 9, 13, 14 and 16. Notwithstanding, without conceding the validity of the rejection and solely to expedite prosecution, the Applicants have elected to present the claimed invention in different terms. Reconsideration and withdrawal of the rejection are respectfully requested.

**Obviousness-type Double Patenting Rejection**

Claims 1-3 and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,905,825 in view of Colpan et al (U.S. Patent 6,383,393). In response, Applicants submit herewith a Terminal Disclaimer.

**Conclusion**

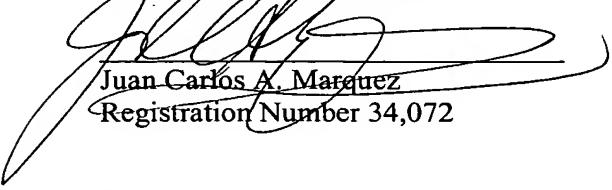
For the reasons presented above, claims 1-3, 10, 14, 15 and 17, all the claims pending in the application, are believed by Applicant to define patentable subject matter and should be passed to issue at the earliest possible time. A Notice of Allowance is requested.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the present application, the Examiner is invited to contact the Applicants' undersigned attorney.

Respectfully submitted,

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